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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,725	07/28/2003	Thorsten Krawinkel	tesa 1611-WCG	6814
27386	7590	04/04/2005		EXAMINER
NORRIS, MC LAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/628,725	KRAWINKEL, THORSTEN	
	Examiner	Art Unit	
	Daniel Zirker	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/03 and 3/4/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the fact that the adhesive composition should be substantially free of plasticizers appears to be a critical limitation of the invention, e.g. note page 6, lines 22-24 in the specification and as such appears to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Additionally, as is taught at page 17, bottom paragraph, the use of SBBS (styrene-butadiene-butylene-styrene) polymers is believed to be a significant preferred embodiment of the invention when such polymers are blended with hydrogenated SEBS polymers. However, no claims appear to be present which is directed to this embodiment and it is suggested that such an embodiment should be claimed by at least dependent claims in the application.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

4. A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Korpman, U.S. Patent 4,024,312. Note particularly the Abstract, column 1 lines 27-32; column 3 lines 23-26, and most particularly column 1 line 62 - column 2 line 43, particularly column 2 lines 17-29. The reference is believed to disclose a genus of stretch release adhesive tapes such as

applicants contemplate (in their dependent claims), wherein the adhesive composition of choice is a linear or radial A-B-A block copolymer wherein the A-block (end blocks) are derived from styrene or styrene homologs, while the B-blocks (center blocks) are derived from conjugated dienes, such as isoprene or butadiene, or from lower alkenes, such as ethylene or butylene (column 2 lines 1-22). Although the reference fails to expressly teach blocks such as center blocks composed of a conjugated diene wherein the fraction of 1,2-linked diene is selectively hydrogenated as applicants claim, note as evidence of the state of the art the teachings at pages 97-98 of the Concise Encyclopedia of Polymer Science and Engineering by Korschwitz, 1990. The reference teaches that the polymer microstructure of butadiene will always form a variety of polymer structures such as the vinyl or 1,2 type butadiene as applicants claim as suitable to be a midblock in their genus of block copolymers, thereby inherently rendering Korpman as an anticipation of at least applicants' broad independent claim, since 1,2 butadiene must necessarily be present in at least some amount when butadiene is present. With respect to the dependent claims, the reference also teaches the various weight percent ranges as such is set forth in claims 2-4, 9 and 10, and also such elements as additives as are set forth in claim 12. Other parameters that

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are not either expressly or inherently disclosed are each believed to be at most obvious optimizations to one of ordinary skill, in the absence of unexpected results.

7. Claims 7 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Korpman. The reference is again relied upon substantially as set forth above, with such parameters as (claim 7) the presence of maleic anhydride-modified vinyl aromatic block copolymers believed to be well known, as is shown as evidence of the state of the art by Lühmann et al., U.S. 6,004,665 at Col 3, lines 55-56. With respect to the various adhesive "sheet strips" such as set forth in claims 14-16 with the presence of laminates and foam carriers, these are each also believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

March 30, 2005

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900
1700

Daniel Zirker